



UNITED STATES
PATENT AND
TRADEMARK OFFICE

NOV 14 2002

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY
AND DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
WWW.USPTO.GOV

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON DC 20001-5303

#8

In re Application of :
Yoshimitsu Iida et al :
Serial No.: 10/069,755 : PETITION DECISION
Filed: February 28, 2002 :
Attorney Docket No.: IIDA=20 :

This is in response to applicants' petition under 37 CFR 1.181, filed October 22, 2002, seeking remailing of an incomplete Office action.

BACKGROUND

A review of the file history shows that this application was filed as the National Phase application of PCT/JP00/05922 and was accepted on February 28, 2002. The examiner assigned to the application mailed a first Office action to applicants in which all of the claims were rejected for the reasons set forth in the IPER and then set forth several specific rejections under 35 U.S.C. 102(b) and 35 U.S.C. 103(a) applying the five references alone and in combination which were discussed in the IPER. The examiner did not provide a separate listing of the references on PTO Form 892 since they were of record in the PCT application. The examiner also did not provide English language equivalents or translations of any of the references as is customary.

DISCUSSION

It is Office policy that all references relied upon in making a rejection of a claim(s) shall be listed on PTO Form 892 unless cited by applicant on Form 1449 or its equivalent. This was not done as the examiner presumed that applicants had received copies of the references with the International Search Report and had them available to review the examiner's Office action. However, it is recognized that applicants' domestic representatives likely did not have the references applied nor English language equivalents thereof. It is also general Office policy to provide English language equivalents of foreign language references where available or actual translations of the reference is readily available. English language abstracts are provided when not readily available and efforts are made to obtain a translation from a translation service and a copy then provided applicant. Although copies of abstracts of the foreign language documents are found in the file it is unclear whether applicants received copies of them.

DECISION

Applicants' petition is **GRANTED**.

Due to the deficiencies of the last Office action, it is vacated without prejudice to the reinstatement of any proper rejections contained therein.

As a new examiner has been assigned to this application the new examiner is directed to promptly consider the references of record, provide a complete Office action and copies of all references relied on to applicants with English language equivalents or translations of any foreign language references, if available, or English language abstracts, if not. Complete translations of any foreign language references must be provided to applicants by the examiner when received.

Should there be any questions with respect to this decision, please contact William R. Dixon, Jr., by mail addressed to: Director, Technology Center 1600, Washington, D.C. 20231, or by telephone at (703)308-3824 or by facsimile transmission at (703) 305-7230.

John Doll
Director, Technology Center 1600